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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,387	08/30/2001	Jean Pierre Bertin	PF000085	9716

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EXAMINER

KNOLL, CLIFFORD H

ART UNIT

PAPER NUMBER

2112

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/942,387

Applicant(s)

PIERRE BERTIN ET AL.

Examiner

Clifford H. Knoll

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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DETAILED ACTION

This Office Action is responsive to communication filed 4/21/05. Currently, claims 1-7 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. *Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent Application 09/943746.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application anticipates each element of instant claim 1.

Claim Rejections - 35 USC § 103

2. *Claims 1 and 3-7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah (US 5784581), in view of Meirsman (US 6636923).*

Regarding claim 1, Hannah discloses first connector (e.g., Fig. 5, "48") and second connector (e.g., Fig. 5, "56") and the switch (e.g., Fig. 7, "72") switching the apparatus to a master mode of operation in relation to the peripheral apparatus in case the absence of the master apparatus is detected on the first connector (e.g., col. 7, lines 29-32), and a slave mode, permitting communication between the apparatus and master apparatus when the master apparatus is detected (e.g., col. 7, lines 32-36). Hannah discloses detecting activity to determine presence, but does not expressly mention the use of a supply voltage as the means to detect the master apparatus; however, Meirsman discloses detecting the presence of the master apparatus by detecting a supply voltage (e.g., col. 4, lines 7-10). It would have been obvious to combine Meirsman with Hannah, because Meirsman teaches the advantages of switching a reconfigurable USB bus system such as Hannah's based on detecting a supply voltage from the master apparatus in response to switching on a device (e.g., col. 2, lines 17-20). Therefore, it would have been obvious to one of ordinary skill in the art to combine Meirsman with Hannah to obtain the claimed invention.

Regarding claim 3, Hannah also discloses the two first I/O pins between the first connector or the second connector and a main microprocessor of the apparatus (e.g.,

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col. 7, lines 43-47) and I/O pins between the first and second connector (e.g., col. 8, lines 14-16).

Regarding claim 4, Hannah also discloses linking the switch to a specific input of the switching circuit (e.g., col. 7, lines 26-29), the input of the controller (e.g., col. 7, lines 40-43), and the input of the main microprocessor (e.g., col. 8, lines 32-33).

Regarding claim 5, Hannah also discloses the master apparatus is the personal computer and the apparatus is the digital decoder (e.g., col. 3, lines 15-16).

Regarding claim 6, Hannah does not expressly disclose the use of the supply voltage; however Meirsman discloses a line transmitting either the supply voltage appearing on the first connector, or a signal representative (e.g., col. 4, lines 9-13).

Regarding claim 7, Hannah also discloses the peripheral apparatus is linked to the second connector by way of a splitter (e.g., col. 6, lines 24-27).

3. *Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah and Meirsman as applied to claim 1 above, in view of standard USB implementation, as further evidenced by Russell (US 6584519).*

Regarding claim 2, Hannah also discloses upstream and downstream connections (e.g., col. 8, lines 10-14), but neglects to mention the standard USB implementational detail which identifies these as A and B type connectors. The Examiner takes Official Notice that these are well-known physical details of the USB standard, as further evidenced by Russell (e.g., Figure 1). It would be obvious to combine the USB type connectors with Hannah because it is advantageous to use

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standard USB connectors when implementing the USB standard in a system such as Hannah. Therefore it would be obvious to one of ordinary skill in the art to combine Hannah and Meirsman with implementation standards to obtain the claimed invention.

Response to Arguments

Applicant's arguments filed 4/21/05 have been fully considered but they are not persuasive.

Regarding the double patenting rejection over claim 2 of Patent Application 09/943746 rejection Applicant argues "that taking into account amendments to the present invention" that the inventions are patentably distinct (p. 4); however, Examiner finds all features are still anticipated by features of 09/943746, including the first and second connectors, the detection of a supply voltage (VBUS), and the master and slave modes of operation responsive thereto. Therefore, the Examiner maintains the double patenting rejection.

Regarding claim 1, Applicant argues that "a timeout signal [is] *used to determine the presence or absence of an active host controller*", and thus concludes that "the means for determining the presence or absence of an active host control is this timer" (p. 6). However, in fact, the timer is used in combination with a detection of signal activity: "a signal is received from an upstream device at step 74, indicating the presence of an active host controller" (col. 7, lines 33-35). From this the Examiner finds that means for detecting and means for detecting triggering are anticipated by Hannah.

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The timer supports this detection by setting a particular time period in which the detection operates. Citations are provided supra to aid in interpreting Hannah in light of amended claims. The detection of a supply voltage rather than the voltage activity of Hannah is found in Meirsman. That it would be obvious to combine this feature with those anticipated by Hannah is the subject of the obviousness rejection maintained supra.

Regarding Meirsman, Applicant further argues that "it is clear that the means of detecting the potential on a pin of a connector does not directly control the communication such as recited (p. 7); however, Meirsman is relied upon only to disclose the use of supply voltage to determine the presence of a master apparatus. The direct control of communication responsive to a voltage presence is a feature anticipated by Hannah.

Thus the Examiner maintains the rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clifford H. Knoll whose telephone number is 571-272-3636. The examiner can normally be reached on M-F 0630-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chk


REHANA PERVEEN
PRIMARY EXAMINER
7/7/05